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EXAMINER				
LEIVA, FRANK M				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
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Office Action Summary

Application No.

10/764,739

Applicant(s)

CONNELLY, MICHAEL P.

Examiner

FRANK M. LEIVA

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 03/30/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 March 2009 has been entered.

Acknowledgements

2. The examiner acknowledges no amendments to claims in applicant's submission filed 30 March 2009.

Response to Arguments

3. Applicant's arguments filed 30 March 2009 have been fully considered but they are not persuasive.

4. Applicant's argument centers on playing two or more sound tracks at the same time; (page 7 of applicant's remarks "*In contrast, the pending claims recite playing an audio track that comprises a plurality of selected audio element tracks that are played at the same time to create the played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game machine based on at least one of random selection and a randomly ordered list. Applicants maintain that Hecht fails to describe playing two or more tracks at the same time. More specifically, the cited paragraph 52 contains the word "simultaneously", but the word is read out of context in the Advisory Action", (page 8) "Further, when the transition occurs on-beat, the "CPU detects sound-causing events and simultaneously plays a new sound recording on-beat with an initial recording". This describes that the CPU detects sound-causing events and simultaneously plays a new sound recording. Although it describes playing a new sound*

recording on-beat with an initial recording, it does not describe playing two sound recordings simultaneously." It is the examiners view that "simultaneously" means at the same time and that a new sound recording is a sound track by definition and being played at the same time as the initial recording and thus modifying the initial recording. Applicant's statement on page 8 of remarks *"More specifically, the 'does A and simultaneously does B' structure of the sentence can only be read as describing that A and B are done simultaneously, especially given the language in the rest of the paragraph indicating that 'the CPU makes a change from playing an initial sound recording to a variant of that sound recording' and subsequent discussion of the transition between playing an initial and a variant sound recording."* Makes the point that the reference discloses playing two tracks at the same time, and although the motivation of Hetch is to modify the original score, one of ordinary skill can see that anytime two tracks are played to form a third, the third is modified from the original score. It is the view of the examiner that Hetch's invention plays multiple tracks at the same time (simultaneously).

5. Regarding the last argument on pages 8 and 9 of applicant's remarks; *"Because the cited Hecht reference fails to discuss playing two or more tracks at the same time, fails to disclose that multiple tracks played at the same time comprise two or more different instruments, and fails to disclose that the multiple audio element tracks are played at the same time to form an audio track based on at least one of random selection and a randomly ordered list, the pending claims are distinct from the cited Hecht reference. Reexamination and allowance of pending claims 1-37 is therefore respectfully requested."* The above argument has been traversed and the rejections to claims 1-37 are found to be proper.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-37 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Bilski* (Fed. Cir. 2007-1 130. 1013012008) where the Fed. Cir. held that method claims must pass the "machine-or- transformation test" in order to be eligible for patent protection under 35 USC 101.

Based on Supreme Court precedent and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC 101 and should be rejected as being directed to non-statutory subject matter. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a 35 USC 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In its recent case, *In re Bilski, et al.*, the Court of Appeals for the Federal Circuit determined that in order to meet the requirements of 35 U.S.C. § 101, method claims must either recite a method of making a physical transformation on a material substance or be explicitly tied to some machine or article of manufacture. The instant claims 1-37 do not meet the criteria set forth in the "machine-or-transformation test" as they are not tied to another specific statutory class. The claims themselves amount to "a gaming system operable to play a sound track" including "selecting audio element tracks". Such process steps lack any tangibility or transformation of any article or materials. The state of the physical device is not conveyed as changing or being

modified from the process steps listed. Therefore the instant claims fail to meet the standard set forth by *In re Bilski* and do not pass the "machine- or-transformation test".

While some of Appellant's dependent claims recite 'played back out of sequence' (Claims 4, 5), there is insignificant post-solution activity which will not transform a patentable principle into a patentable process. As noted, appellant appears to be attempting to patent an idea or fundamental principle since any and all methods of providing the projected effect of recording the played audio track would infringe upon the claimed invention. The Court in *Bilski* clearly states that the claims that preempt substantially all uses of a fundamental principle are not drawn to patent eligible subject matter.

As such claims 1-37 are held to be directed towards unpatentable subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. **Claims 1-37 are rejected under 35 U.S.C. 102(a) as being anticipated by Hecht et al (US 2003/0073489 A1).**

10. **Regarding claims 1, 19 and 37;** Hecht discloses a computerized gaming system, comprising: a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a wagering game on which monetary value can be wagered, (¶ [0004]); and an audio module, the audio module operable to play an audio track, the audio track comprising a plurality of selected audio element tracks that are played at the same time to create the played audio track, (¶ [00055]), wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game

machine based on at least one of random selection and a randomly ordered list, (§ [0009, 0043]), where the sound change Random access memory is considered to be a randomly ordered list, and (§ [0050]) shows that multiple instruments are played and that the music is played synchronized and same key.

11. Regarding claims 2 and 20; Hecht discloses wherein each audio element track comprises one or more instruments not present in the other audio element tracks, (§ [0005-0007]), wherein the system can make changes to the track by changing instruments or swapping voice from different singers means that the system sound files include instrument sound separate from voice sounds.

12. Regarding claims 3 and 21; Hecht discloses wherein at least one audio element track comprising one or more specific instruments comprises multiple phrases independently selectable for playback to create the played audio track, (§ [0005]), where the changes include skipping to different section of the song, meaning that the songs are made of partitions or sections (phrases in the song).

13. Regarding claims 4 and 22; Hecht discloses wherein the multiple phrases are played back out of sequence to create the played audio track, (§ [0043]), wherein if they are played randomly, they are out of sequence.

14. Regarding claims 5 and 23; Hecht discloses wherein the phrase sequence played back to create the played audio track comprises a randomly selected phrase order, (§ [0043]), wherein if they are played randomly.

15. Regarding claims 6 and 24; Hecht discloses wherein the phrase sequence played back to create the played audio track is provided by an ordered list of phrases, (§ [0005 and 0043]), wherein the sound change random access memory is considered to be a list of audio track to be played.

16. Regarding claims 7 and 25; Hecht discloses wherein the phrase sequence played back to create the played audio track comprises a phrase sequence selected based on priority weighting assigned to the phrases, (§ [0038]), including primary sound files which are used to start the sound or give background to the played track.

17. Regarding claims 8 and 26; Hecht discloses wherein two or more audio element tracks are randomly combined to create the played audio track, (§ [0052]), whereas the tracks are played simultaneously and on-beat with the initial recording.

18. Regarding claims 9 and 27; Hecht discloses, wherein two or more audio element tracks are combined according to a predetermined list of audio element track combinations, (§ [0052]), whereas the tracks are played simultaneously and on-beat with the initial recording, these audio elements taken from the sound change random access memory list.

19. Regarding claims 10 and 28; Hecht discloses wherein two or more audio element tracks are selected and combined to produce the played audio track, the selection comprising evaluation of priority weighting of the various audio element tracks, (§ [0008 and 0038]), where there are specific instructions to follow priorities according to game changes and primary sounds.

20. Regarding claims 11 and 29; Hecht discloses wherein the audio element tracks are played back repeatedly, and wherein the length of at least two of the audio element tracks are of different length, (§ [0042]), wherein if the CPU determines the duration of play, means that audio elements are not limited to be of the same duration.

21. Regarding claims 12 and 30; Hecht discloses wherein the played audio track further comprises a portion that is not a combination of audio element tracks, (§ [0038]), where the primary sound files appear to be plain files to be changed and combined, but for the start comprise a portion that not yet altered.

- 22. Regarding claims 13 and 31;** Hecht discloses wherein at least one of the plurality of audio element tracks is played using at least one randomized parameter, the parameters including at least one of volume, panning, reverb, equalization, compression, distortion, flange, and phase parameters, (¶ [0005]).
- 23. Regarding claims 14 and 32;** Hecht discloses wherein the audio element phrases are sorted into at least two subgroups, (¶ [0048]).
- 24. Regarding claims 15 and 33;** Hecht discloses wherein the audio elements in the phrase subgroups are grouped by compatibility with other audio element phrase groups, (¶ [0048]).
- 25. Regarding claims 16 and 34;** Hecht discloses wherein the audio element tracks have different sampling rates, (¶ [0005]).
- 26. Regarding claims 17 and 35;** Hecht discloses wherein at least one of the audio element tracks comprises music, (¶ [0038]).
- 27. Regarding claims 18 and 36;** Hecht discloses wherein at least one of the audio element tracks comprises sound effects, (¶ [0038]).

Examiner's Note

- 28.** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

08/04/2009

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714